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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **HealthFirst, Inc.**

Serial Nos. 75/117,256 and 75/117,694

**Oliver R. Chernin of Deutsch Klagsbrun & Blasband for
HealthFirst, Inc.**

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Before Seeherman, Bucher and McLeod, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

HealthFirst, Inc. has applied to register HEALTHFIRST
and design,¹ and HEALTHFIRST "WHERE THE CARE STARTS" and
design, as shown below, for primary health care services.²

¹ Application Serial No. 75/117,694, filed June 12, 1996,
asserting a bona fide intention to use the mark in commerce.

² Application Serial No. 75/117,256, filed June 12, 1996,
asserting a bona fide intention to use the mark in commerce.

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In both applications, the mark is lined for the colors yellow and orange.

Registration has been refused to both marks pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of a registration owned by Greenville Hospital System Corporation for HEALTHFIRST for "administration of employee health care benefit plans"³ It is the Examining Attorney's position that applicant's mark so resembles the registered mark that, if used on applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs, but oral hearings were not requested. Because both appeals involve the same issue, we have determined them in a single opinion.

³ Registration No. 1,683,958, issued April 21, 1992; Section 8 affidavit accepted; Section 15 affidavit received. Registration was also refused in view of another registration, owned by a different entity, for H1 MID-AMERICA HEALTH FIRST for "health care services." (Registration No. 1,921,230.) However, this registration was subsequently cancelled, and therefore the Examining Attorney acknowledged in her brief that it was no longer a bar to registration of applicant's mark.

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Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). We turn first to a consideration of the services. Applicant's identified services are primary health care services, while the services identified in the registrations are administration of employee health care benefit plans. Although these services are not identical, it is well established that it is not necessary that the goods or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

In this case, the Examining Attorney has made of record a number of third-party registrations which show

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that the third parties have registered marks for both health care services and administration of health care benefit plans. See, for example, Reg. No. 2,046,247 for, inter alia, administering health care plans for others, and providing health care services; Reg. No. 1,967,874 for, inter alia, administration of employee benefit plans, managed health care services, and health care services by physicians; Reg. No. 1,667,808 for, inter alia, administration of health insurance benefit plans, and health care and medical services and related activities.

Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

These registrations, thus, serve to demonstrate that services of the type identified in applicant's applications and the cited registration can emanate from the same source, and be offered under the same mark.

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Further, even though the services identified in the registration would be directed to employers, the same class of consumers is likely to encounter both kinds of services. That is, employees, who would be the consumers of primary health care services, would also be aware of the company administering their health care benefit plan since they would contact that company for payment of health care claims and questions about health care coverage.

Hence, we find that applicant's and the registrant's identified services are closely related, and that the public is likely to believe, if they were offered under the same or similar marks, that they emanate from the same source.

Applicant raises an estoppel argument with respect to our consideration of the registrant's services, based on statements registrant made during the examination of its application, when it was attempting to overcome the citations of two registrations which have, in the meantime, been cancelled for failure to file Section 8 affidavits. Those registrations were for the mark HEALTHFIRST for business management and administrative services for entities providing medical care, and HEALTH FIRST for ambulatory medical services. In arguing against the likelihood of confusion, registrant (then applicant)

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asserted that the services provided by the registrants and itself were so diverse to be unlikely to cause confusion. In particular, it argued, with respect to the registration for "ambulatory medical services", that [registrant] "does not provide medical care under the mark HEALTHFIRST but provides for medical reimbursement services under the mark." As a result of these statements, applicant in the present case argues that the identification of services in the cited registration is quite specific and does not involve providing health care services and, further, that registrant's expressed views on the differences between its services and those in the registrations cited against it should have some sort of estoppel effect on the Board's determination.

There are several problems with applicant's argument. First, it is well established that a party's view on likelihood of confusion, made during the earlier examination of its application, cannot be treated as an admission. **Interstate Brands Corp. v. Celestial Seasonings, Inc.**, 576 F.2d 926, 198 USPQ 151 (CCPA 1978). That a party earlier indicated a contrary opinion respecting the conclusion is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. **Specialty**

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Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d
669, 223 USPQ 1281 (Fed. Cir. 1984).

Second, whatever opinion the registrant may have had in 1989 with respect to the similarity of its services with ambulatory medical services and business management and administrative services for entities providing medical care, may have changed in the ten-plus years since its response was written. There is no question that there have been significant changes in the entire health care field during this period.

Most importantly, the question before us is not whether the registrant renders health care services, or even whether it intends to render them.⁴ The question is whether consumers are likely to believe that a company which administers employee health care benefit plans is likely to also offer primary health care services, and the Examining Attorney has established that through the third-party registrations which she has made of record. And, although we have not relied on this in reaching our decision, it is interesting to note that the first use

⁴ In this connection, we have given no weight to the Examining Attorney's argument that medical care services are within the natural expansion of the registrant's services, nor have we considered the registrant's currently pending application, referred to by applicant in its submissions, for the same mark for, inter alia, various, health care services.

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dates claimed in many of these registrations are subsequent to 1989, which may reflect a change in the industry since registrant made the statements in its application.

This brings us to a consideration of the marks.

Because applicant is appealing the refusal of registration of two different marks, we will first consider the mark in Application Serial No. 75/117,694, for HealthFirst and sun design.

As applicant and the Examining Attorney have pointed out, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The registered mark consists of just the words HEALTH FIRST. Because the mark is registered in "typed" form, the registration encompasses all normal representations of the words, and would certainly include use of the mark with initial capital letters and the rest of the letters in lower case, viz. Health First, a depiction very like applicant's. Applicant's mark consists of the words

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HealthFirst with a sun design. Although we agree with applicant that the term HEALTH is descriptive, and that the words HealthFirst are entitled to a narrower scope of protection than an arbitrary mark, as discussed infra, we cannot agree that the sun design is the dominant part of the mark. The words HealthFirst are not only superimposed on the sun design, but they extend beyond it on both the left and right, and present a strong visual element.

Moreover, it is by the words that consumers will refer to applicant's services, and therefore the words are more likely to be noted and remembered. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). Therefore, because the words HealthFirst in applicant's mark will make a greater impression on consumers, we find that the word portion of the mark is the dominant element. This dominant word element is legally identical in appearance to the registered mark, and the additional design element in applicant's mark is not sufficient to distinguish the marks.

We would also add that the marks are identical in pronunciation, and in connotation. In this connection, we reject applicant's argument that its mark suggests warm and caring health care services. The concept of warmth, in connection with caring health care services, relates to

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human warmth, and consumers would not perceive it to be represented by the sun.

Accordingly, we find that the marks, when compared in their entireties, convey the same commercial impressions.

As mentioned above, we recognize that HEALTH FIRST is a suggestive mark, and is therefore entitled to a more limited scope of protection than an arbitrary mark would enjoy.⁵ Applicant has made of record several third-party registrations, both current and now cancelled, for marks which include this term identifying goods and services in the health care field. Specifically, there are six current registrations⁶ and three cancelled registrations for such marks.

⁵ Applicant refers to HEALTHFIRST as being non-distinctive and descriptive, but we regard this to be a reference to the weakness of the mark, rather than an impermissible attack on the cited registration as being descriptive, an attack which would be fruitless in any event because the registration is more than five years old.

⁶ HEALTHFIRST for emergency drug kits for use with patients in acute medical situations (Reg. No. 1,999,391, issued Sept. 10, 1996); HEALTH FIRST CONSULTING CORPORATION and design for educational services, namely, conducting seminars in the field of health (Reg. No. 1,752,957, issued Feb. 16, 1993) and promoting the public awareness of the need for healthier lifestyles and conducting health screenings and tests (Reg. No. 1,769,513, issued May 4, 1993); HEALTHFirst, stylized, for computer software and hardware for promoting and evaluating human wellness (Reg. No. 2,206,503, issued Dec. 1, 1998); "i Patient Health First, A Series of Patient Services from Hoechst Marion Roussel" and design for, inter alia, computer programs for use in disseminating information about health care improvement, magazines and newsletters about health care, and consulting services in the field of health care (Reg. No. 2,259,801, issued July 6, 1999); HEALTH FIRST for mail order and retail store

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These registrations are probative to show, in the manner of dictionary definitions, that the term HEALTH FIRST has a significance or meaning in this field. See **Conde Nast Publications Inc. v. Miss Quality, Inc.**, 180 USPQ 149 (TTAB 1973).

Although the term HEALTH FIRST is entitled to a more limited scope of protection than an arbitrary mark, neither is the mark so highly suggestive that it is entitled to protection only against the registration of virtually identical marks for identical services. The word FIRST, as used in the mark, is not merely laudatory, as applicant suggests; rather, the mark as a whole projects the sense of putting one's health first, or of putting the consumer's health first. In this case we find that applicant's mark is so similar to registrant's, and the services are so closely related, that applicant's mark for its identified services is likely to cause confusion with the cited registration. The additional element of the sun design is simply not sufficient to distinguish the marks, as other coexisting third-party marks have been distinguished by other elements or by more significant differences in the

services in the field of health, therapy and fitness not including vitamins, minerals and dietary supplements (Reg. No. 2,312,088, issued Jan. 25, 2000).

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goods and/or services. Although consumers may note the inclusion of the sun design in applicant's mark, they are likely to think that the mark is a variant of the registrant's mark, rather than as indicating services coming from a separate source.

For the same reason, i.e., the strong similarity between the marks, we are not persuaded that consumers, even if they exercise care in choosing a health care provider, will recognize that these marks indicate separate sources of the services.

With respect to Serial No. 75/117,256, this application is for the same mark as that in Serial No. 75/117,694, HealthFirst and sun design, with the addition of the phrase "Where the care starts" in smaller, italicized lettering below and to the right of the sun design. This phrase, as it is used in the mark, conveys the commercial impression of a slogan referring to the services. However, for the reasons given in connection with our discussion of the HealthFirst and sun design, the slogan and the sun design are not sufficient to distinguish applicant's mark from the cited registration. Just as the HealthFirst and sun design mark would be perceived by consumers as a variant of the registrant's HEALTH FIRST mark, the HealthFirst and sun design with the laudatory

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slogan would also be perceived as a variant mark, and not as a separate source indicator.

Accordingly, we find that both of applicant's marks-- HealthFirst and sun design; and HealthFirst, sun design and "Where the care starts"--are, if used on applicant's identified services, likely to cause confusion with HEALTH FIRST for the services identified in the cited registration.

As a final comment, we note that applicant has referred in its briefs to another application for HEALTHFIRST, filed by a third party, which was examined by the Examining Attorney handling applicant's applications during the same time period applicant's applications were being examined. That application was approved for publication, while registration to applicant's applications was refused. Applicant does not disagree with the Examining Attorney's decision in that case, but asserts that the Examining Attorney's approval of the third-party application mandates registration of applicant's marks.

The question of whether or not the Examining Attorney properly examined a different application is not before us in this appeal. What we must decide here is whether applicant's marks are likely to cause confusion with the cited registration, and that we have done. A decision by

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the Examining Attorney in connection with another application is certainly not binding on our decision here. Having said that, we note in passing that the services in the third-party application are different from applicant's identified services.

Decision: The refusals of registration with respect to Applications Serial Nos. 75/117,694 and 75/117,256 are affirmed.

E. J. Seeherman

D. E. Bucher

L. K. McLeod
Administrative Trademark Judges
Trademark Trial and Appeal Board